

REMARKS

Claims 1-20 are currently pending in the application. Claims 7 and 8 were amended to correct misspellings. As such, the amendments do not raise new issue, add new matter, or narrow the scope of either claim. Reconsideration of the rejected claims in view of the following remarks is respectfully requested.

Drawing Objections

Figure 3 was objected to as having a reference numeral (e.g., 44) that was not described in the specification. To obviate this objection and correct this informality, the specification was amended to describe reference numeral 44. This amendment to the specification does not introduce new matter or raise new issues, because block 44 and its function were previously and clearly depicted in the specification at the time of filing. Accordingly, the Examiner is respectfully requested to withdraw the objection of Figure 3, and to enter this amendment into the record.

35 U.S.C. §102/103 Rejections

Claims 1-5, 7-11, 13 and 14 were rejected under 35 U.S.C. §102(e) for being unpatentable over U.S. Patent No. 6,697,992 B2 to Ito *et al.* ("Ito"). Claims 6, 12 and 15-20 were rejected under 35 U.S.C. §103(a) over Ito. Applicant submits that the rejections of claims 1-14 are rendered moot in view of the Declaration submitted by the named inventor under 37 C.F.R. §1.131.

More specifically, Applicant submits that the Rule 131 Declaration is formally and substantively sufficient to establish that the Inventor had conceived and reduced to practice with due diligence the invention defined in at least independent claims 1, 10, and 15 starting before the effective date of the primary reference to Ito, i.e., August 8, 2001. The statements in the Declaration show that the formal requirements of §1.131 are satisfied, namely:

- (1) the rejections to be overcome are under §102(e) and §103(a),

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(2) all the acts for completing the invention of claims 1, 10 and 15 were performed in this country, and

(3) the effective date of the Ito reference, i.e., August 8, 2001, is not more than one year prior to the filing date of the present application in this country.

It is respectfully submitted that the statements in the Declaration are also sufficient to satisfy the substantive requirements of 37 C.F.R. §1.131. The Declaration sets forth specific facts, of sufficient character and weight, to establish a **date of conception** before the effective date of the Ito reference of August 8, 2001, and to show that the Inventor and his attorneys exercised **due diligence** from a time before the effective filing date of the Ito primary reference to a constructive reduction to practice, i.e., to the filing of the application.

Date of Conception

As stated in the Declaration, a memory system having a reduced refresh rate in a sleep mode, and a method for reducing the refresh rate of a memory in sleep mode, as disclosed and recited in claims 1, 10, and 15 of the application (and those claims dependent thereon) was conceived by the Inventor before the effective date of the Ito reference. Invention disclosure documentation is submitted with the Declaration as supporting evidence of this prior date of conception. It is respectfully submitted that at least the invention disclosure evidence shows that the Inventor had a definite and permanent idea of the complete and operative invention of claims 1, 10, and 15, as presently pending, prior to the August 8, 2001 effective date of the Ito reference.

In particular, the accompanying evidence shows, textually and pictorially, the features of claims 1, 10, and 15. The original copy of the invention disclosure documentation evidences a date antedating the August 8, 2001 effective date of the Ito reference. This and all other pertinent dates have been removed from the photocopies submitted with the Declaration to prevent any potential prejudice to Applicant. It is noted that the figures provided are illustrative in nature and are not intended as limiting features of the invention.

Applicant further submits that the Declaration filed herewith shows, unequivocally, that the Inventor had in their possession a definite and permanent idea of the complete and operative invention of claims 1, 10, and 15 starting before August 8, 2001 in a manner sufficient to satisfy the requirements of conception, as set forth in M.P.E.P. §§ 715.07 and 2138.04, and thus constitute *prima facie* evidence of Applicant's date of conception of the invention in this country before the effective date of the Ito reference.

Due Diligence

Applicant further submits that the Declaration shows the Inventor and his attorneys exercised due diligence from a time before the August 8, 2001 effective date of the Ito reference to a constructive reduction to practice, realized by the filing of the above-identified patent application on February 1, 2002.

The invention disclosure documentation was completed by the Inventor prior to the Ito reference date of August 8, 2001. IBM authorized outside counsel at the undersigned firm to prepare the application, and supplied the invention disclosure to outside counsel in a timely manner. Numerous discussions between the Inventor and counsel took place until a first draft of the application was forwarded to Inventor, Kraig R. White. Revisions were made and subsequent drafts were prepared and reviewed by the Inventor, until a final draft was forwarded to IBM for execution on January 12, 2002, and subsequent filing on February 1, 2002.

Outside patent counsel also acted in an expeditious manner to prepare and forward the application to filing. Under M.P.E.P. § 2138.06, only ***reasonable*** diligence is required in this regard. More specifically, § 2138.06 states that a patent attorney will be held to have exercised reasonable diligence if the attorney worked reasonably hard on the application during the critical period, taking into consideration any backlog of unrelated cases the attorney may have had and his completion of those cases along with the present application in chronological order.

Applicant respectfully submits that the Declaration shows that his patent attorneys acted sufficiently expeditiously to satisfy the requirements of due diligence. Applicant submits that the Declaration submitted herewith are sufficient to show that the Inventor and his attorneys exercised the due diligence required under 37 C.F.R. § 1.131. The Declaration shows that the

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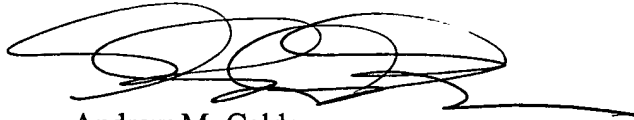
Inventor remained in regular contact with patent attorneys to answer questions, provide technical explanation, and supply the supplemental disclosure materials necessary for enabling the application to be filed in an expeditious manner.

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CONCLUSION

Applicant believes that a full and complete response has been made to the pending Office Action and respectfully submits that all of the stated objections and grounds for rejection have been overcome or rendered moot. Applicant submits that all of the claims are allowable and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Prompt and favorable consideration of this reply is respectfully requested. Please charge any deficiencies in fees and credit any overpayment of fees to **IBM Deposit Account No. 09-0458** (Fishkill).

Respectfully submitted,



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